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OFFICE OF PETITIONS

In re Application of
Shahinpoor, et al. :
Application No. 09/899,874 :
Filing Date: 5 July, 2001 :
Attorney Docket No. 2313-00 :

This is a decision on the renewed petition filed on 16 November, 2005, alleging unavoidable delay under 37 C.F.R. §1.137(a).

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.137(a) is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b)¹ (as to unintentional delay) must be submitted within two (2)

¹ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";

- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Allowance/Allowability and Fees Due mailed on 10 November, 2004, with reply due under a non-extendable deadline on or before 10 February, 2005;
- the application went abandoned after midnight 10 February, 2005;
- on 22 November, 2004, and 15 March, 2005, Petitioner filed a request for a correction of the title of the application from "A Method of Frabricating a Dry Electro-Active Polymeric Synthetic Muscle" to "A Method of Fabricating a Dry Electro-Active Polymeric Synthetic Muscle" (emphasis supplied), which requests appear—from the Office reply of 28 March, 2005—to have been mis-understood/mis-interpreted;
- however, this was resolved by the 12 April, 2005, Supplemental Notice of Allowability mailed by the Examiner to address the misspelling;
- the Office mailed the Notice of Abandonment on 14 April, 2005;
- Petitioner paid the Issue Fee on 28 April, 2005, at which time he also filed a request to withdraw the holding of abandonment, in which he averred that the Examiner instructed him to delay in payment of the Issue Fee, which request was dismissed on 10 October, 2005;
- 16 November, 2005, Petitioner filed the instant petition with fee, and averred once again that the Examiner instructed him over the telephone to delay in payment of the Issue Fee—this is the basis of Petitioner's allegation of unavoidable delay.

Petitioner, long a registered practitioner before the Office, is well aware that not only is all

practice before the Office is in writing (under 37 C.F.R. §1.2²), but that once the Notice of Allowance/Allowability and Fees Due (the Notice) is mailed, in the absence of a written action withdrawing the Notice no one has the authority to instruct the Petitioner not to pay the Fees Due.³

Petitioner was on the right track as he sought in writing from the Office a correction of the title misspelling, and, in fact, the Examiner ordered, via Supplemental Notice of Allowability, the correction at issue.

² The regulations at 37 C.F.R. §1.2 provide:
§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

³ See: MPEP §1306, in pertinent part:

1306 Issue Fee [R-2]

The issue fee *and any required publication fee are due 3 months from the date of the Notice of Allowance. The amount of the issue fee *and any required publication fee are shown on the Notice of Allowance, which will reflect any issue fee previously paid in the application. For example, if the application was allowed and the issue fee paid, but applicant withdrew the application from issue and filed a Request for Continued Examination (RCE) and the application was later allowed, the Notice of Allowance will reflect an issue fee amount that is due that is the difference between the current issue fee amount and the issue fee that was previously paid. Had applicant filed a Continued Prosecution Application (CPA) instead of an RCE, the issue fee required would be the current issue fee amount and would not reflect any issue fee paid before the CPA was filed because the issue fee was paid in a prior application. Note that because the amount of the *fees(s) due is determined by the fees set forth in 37 CFR 1.18 which are in effect as of the date of submission of payment of the *fees(s), the amount due at the time the fee(s) are paid may differ from the amount indicated on the Notice of Allowance. Accordingly, applicants are encouraged, at the time of submitting payment of the *fees(s), to determine whether the amount of the issue fee due *or any required publication fee has changed to avoid the patent lapsing for failure to pay the balance of the issue fee due (37 CFR 1.317) or becoming abandoned for failure to pay the publication fee. The amounts due under 35 U.S.C. 41(a) (i.e., the issue fee, but not the publication fee) are reduced by 50 per centum for small entities.

Applicants and their attorneys or agents are urged to use the *Fee(s) Transmittal form (PTOL-85B) provided with the Notice of Allowance when submitting their payments. *Unless otherwise directed, all post allowance correspondence should be addressed *Mail Stop Issue Fee."

*Where it is clear that an applicant actually intends to pay the issue fee and required publication fee, but the proper fee payment is not made, for example, an incorrect issue fee amount is supplied, or a PTOL-85B Fee(s) Transmittal form is filed without payment of the issue fee, a general authorization to pay fees or a specific authorization to pay the issue fee, submitted prior to the mailing of a notice of allowance, will be allowed to act as payment of the correct issue fee. 37 CFR 1.311(b). In addition, where the deposit account information is added to the Fee(s) Transmittal form (PTOL-85B), but the check box authorizing that the deposit account be charged the issue fee is not checked, the deposit account will still be charged the required issue fee and any required publication fee.

Technology Center personnel should forward all post allowance correspondence to the *Office of Initial Patent Examination (OIPE). The papers received by the *OIPE will be scanned and matched with the appropriate application and the entire application will be forwarded to the appropriate Technology Center for processing.

The payment of the issue fee due may be simplified by using a U.S. Patent and Trademark Office Deposit Account or a credit card payment with form PTO2038 for such a fee. See MPEP § 509. However, any such payment must be specifically authorized by reference to the "issue fee" or "fees due under 37 CFR 1.18."

The *fee(s) due will be accepted from the applicant, assignee, or a registered attorney or agent, either of record or under 37 CFR 1.34(a).

The *Director has no authority to extend the time for paying the issue fee. Intentional failure to pay the issue fee within the 3 months permitted by 35 U.S.C. 151 does not amount to unavoidable or unintentional delay in making payment. (Emphasis supplied.)

Clearly Petitioner cannot make a satisfactory showing as to unavoidable delay and his only alternative is to file a petition alleging unintentional delay, with fee, point to the reply formerly submitted in the form of fees due, and make the statement of unintentional delay.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁴

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁵

Delays in responding properly raise the question whether delays are unavoidable.⁶ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁷ And the Petitioner must be diligent in attending to the matter.⁸ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁹))

⁴ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁵ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁶ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁷ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁸ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁹ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

Once again, Petitioner has failed to satisfy the “showing” requirement of the regulation.

CONCLUSION

The instant petition under 37 C.F.R. §1.137(a) hereby is **dismissed**.

ALTERNATIVE VENUE

It appears that Petitioner will be unable to make a showing of unavoidable delay. Petitioner's only alternative to irretrievable abandonment is to file a petition under 37 C.F.R. §1.137(b) (state therein that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional”).

Thus, Petitioner may wish to supplement the petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the “showing” burden is much less onerous.

Further correspondence with respect to this matter should be addressed as follows:¹⁰

By mail: Commissioner for Patents¹¹
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
 (571) 273-8300
 ATTN.: Office of Petitions

¹⁰ On July 15, 2005, the Central Facsimile (FAX) Number will change from (703) 872-9306 to (571) 273-8300. Faxes sent to the old number will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information, see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf>.)

¹¹ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
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Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to read "John J. Gillon, Jr.", written over the printed name.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions